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**REMARKS**

This response is intended as a full and complete response to the non-final Office Action mailed April 12, 2007. In the Office Action, the Examiner notes that claims 106, 108-115 and 117-123 are pending and rejected. By this response, Applicant has amended independent claims 106, 115 and 120. Support for the amendments may be found in the Applicant's specification on at least page 82, lines 14-16 and page 94, lines 9-22.

In view of both the amendments presented above and the following remarks, Applicant submits that the claims now pending in the application are non-obvious under the provisions of 35 U.S.C. §103. Thus, Applicant believes that all the claims are allowable.

It is to be understood that Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive including amendments.

**35 U.S.C. §103 Rejection of Claims 106-110, 112-118, and 120**

Claims 106-110, 112-118, and 120-123 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,990,927 to Hendricks (hereinafter "Hendricks") in view of U.S. Patent 5,999,207 to Rodriguez (hereinafter "Rodriguez") and U.S. Patent Application Publication 2001/0013021 to Saito (hereinafter "Saito"). Applicant respectfully traverses the rejection.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. The Hendricks, Rodriguez and Saito references, alone or in combination, fail to teach or suggest all of the limitations recited in claim 106, and thus fail to teach or suggest Applicant's invention as a whole.

The Applicant respectfully submit that the combination of Hendricks, Rodriguez and Saito fail to teach or suggest an apparatus comprising a means for multiplexing a non-video data signal with a downstream communication signal, wherein a non-video data signal comprises at least one of: an electronic book, data file, document,

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spreadsheet, graphic, program, text stream, web page or interactive whiteboard and a means for simultaneously displaying the non-video data signal with the television program and a video of the downstream communication signal on the display device, as positively recited by the Applicant's independent claims. In an exemplary embodiment of the Applicant's invention, a user may send non-video media during a television program and video call. (See e.g., Applicant's specification, p. 94, ll. 9-22.) For example, two sports enthusiasts may each watch the same sports event program while engaging in an interactive picture-in-picture video call to discuss the action and interact on an interactive whiteboard that is displayed simultaneously with the video call and television program. (See *Id.* at page. 99, ll. 8-13.)

The Applicant respectfully submits that this feature is not taught by Hendricks, Rodriguez or Saito, alone or in any permissible combination.

Hendricks discloses hardware upgrades for a set top terminal. In particular, the Hendricks reference discloses the hardware upgrades as shown in Figures 9a, 9b, 10, 12a and 12b. Hendricks does not teach or suggest the STT having a means for multiplexing a non-video data signal with a downstream communication signal, wherein a non-video data signal comprises at least one of: an electronic book, data file, document, spreadsheet, graphic, program, text stream, web page or interactive whiteboard and a means for simultaneously displaying the non-video data signal with the television program and a video of the downstream communication signal on the display device.

Rodriguez and Saito fail to bridge the substantial gap left by Hendricks. Rodriguez discloses a graphical user interface for a videophone in a cable television system that allows the user to access the videophone functionalities with an input control device and a television monitor. This videophone may be implemented as a plug-in device to a set-top box. However, Rodriguez does not teach or suggest the claimed feature of a means for multiplexing a non-video data signal with a downstream communication signal, wherein a non-video data signal comprises at least one of: an electronic book, data file, document, spreadsheet, graphic, program, text stream, web page or interactive whiteboard and a means for simultaneously displaying the non-video

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data signal with the television program and a video of the downstream communication signal on the display device.

Saito discloses an apparatus for data copyright management. (See Saito, Abstract.) Saito also does not teach or suggest a means for multiplexing a non-video data signal with a downstream communication signal, wherein a non-video data signal comprises at least one of: an electronic book, data file, document, spreadsheet, graphic, program, text stream, web page or interactive whiteboard and a means for simultaneously displaying the non-video data signal with the television program and a video of the downstream communication signal on the display device.

Thus, Hendricks, Rodriguez and Saito, alone or in combination, fail to teach or suggest the Applicant's invention as a whole. Moreover, because that feature is not taught or suggested by any of the references, it is improper hindsight to pick and choose the references to recreate this feature when the teaching is only found in the Applicant's disclosure.

As such, Applicant submits that independent claim 106 is patentable under 35 U.S.C. §103(a) over Hendricks in view of the Rodriguez and Saito references alone or in combination. Moreover, independent claims 115 and 120 contain substantially similar limitations as those discussed above in regards to claim 106. Therefore, claims 115 and 120 are also allowable under 35 U.S.C. §103. Dependent claims 108-110 and 112-114, 117-118 and 121-123 depend directly or indirectly from independent claims 106, 115 and 120 and recite additional limitations thereof. As such and for at least the same reasons discussed above with respect to claims 106, 115 and 120 these dependent claims are also non-obvious in view of Hendricks, Rodriguez and Saito alone or in combination under 35 U.S.C. §103. Therefore, Applicant respectfully requests that the rejection be withdrawn.

### **35 U.S.C. §103 Rejection of Claims 111 and 119**

The Examiner has rejected claims 111 and 119 under 35 U.S.C. §103(a) as being unpatentable over Hendricks, Rodriguez and Saito in view of U.S. Patent 5,867,227 to Schindler et al. (hereinafter "Schindler"). Applicant respectfully traverses the rejection.

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Claims 111 and 119 depend indirectly from independent claims 106 and 115 and recite additional limitations thereof. Moreover, for at least the reasons discussed above, Hendricks, Rodriguez and Sato fail to teach or suggest Applicant's invention as recited in claims 106 and 115. Accordingly, any attempted combination of Hendricks, Rodriguez and Sato with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicant submits that dependent claims 111 and 119 are non-obvious and are patentable under 35 U.S.C. §103. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

### CONCLUSION

Applicant submits that claims 106, 108-115 and 117-123 are in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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